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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/815,621

04/02/2004

Kia Silverbrook

HYC001US

9577

24011 7590 09/23/2008  
SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

MOSSER, ROBERT E

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

09/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/815,621	<b>Applicant(s)</b> SILVERBROOK ET AL.	
	<b>Examiner</b> ROBERT MOSSER	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32,34 and 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32,34 and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Allowable Subject Matter*

The indicated allowability of claims **32**, **34**, and **38** is withdrawn in view of the newly discovered reference(s) to Stangl (US 7,197,642). Rejections based on the newly cited reference(s) follow.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim **34** is rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman (US 5,080,364).

Seidman teaches competition system including the use of machine readable coded data printed on the label of a product. The system of Seidman further teaches interaction data from a barcode reading device indicating the reading of a barcode and

affecting the entry into a competition responsive thereto (*Seidman* Figure 1, 2; Col 2:26-32, 2:61-63).

Seidman does not explicitly teach limiting the number of messages communicated from the application to the user to a predetermined number of messages however figure 2 of Seidman would implicitly allow for a predetermined maximum number of messages from the application to the user based on the flow chart presented therein. Accordingly it would have been obvious to one of ordinary skill in the art at the time of invention to employ a predetermined limit the number of messages presented to the user from an application in the invention of Seidman because as disclosed by Seidman only a finite number of messages are required to practice the invention.

Claim **32** is rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman (US 5,080,364) in view of Stangl (US 7,197,642).

Seidman teaches competition system including the use of machine readable coded data printed on the label of a product. The system of Seidman further teaches interaction data from a barcode reading device indicating the reading of a barcode and affecting the entry into a competition responsive thereto (*Seidman* Figure 1, 2; Col 2:26-32, 2:61-63).

Seidman however is silent regarding explicitly teaching the use of temporary communication addresses. With regards to this feature the prior art of Stangl teaches the use of temporary communications addresses to conceal the actual communication address of one party from another (*Stangl* Col 2:44-56). It would have been obvious to

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one of ordinary skill in the art at the time of invention to have incorporated the use of a temporary communications address in the invention of Seidman because such a combination would represent the mere combination of known communication techniques through conventional means that would yield expected and predictable results.

Claim **38** is rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman (US 5,080,364) in view of Silverbrook et al (US 6,457,883) in further view of Stangl (US 7,197,642).

Seidman teaches the invention as taught above including the verification of competition entry through the presentation of an award (*Seidman* Figure 2) however, Seidman is silent regarding the explicit teaching of incorporating a sensing device ID, or the allocation of a temporary registration. The reference of Stangl teaches the utilization of temporary communications addresses to conceal the actual communication address of one party from another (equivalently understood as a temporary registration) as cited in the above combination. With regards to the use of the ID feature, Silverbrook teaches the inclusion and transmission of a application alias ID, user ID, and pen ID (*Silverbrook* Elm 65; Col 37:22-30). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the use of device identifiers in the invention of Seidman and Stangl because such a combination would represent the mere combination of known communication techniques through conventional means that would yield expected and predictable results.

### ***Response to Arguments***

Claims 32,34, and 38 were previously indicated allowable in the office action dated March 18<sup>th</sup>, 2008 however upon subsequent review of the pending claim language and discovery of the reference to Stangl the above rejections were determined to be pertinent to the allowability of the pending claimed subject matter.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/  
Supervisory Patent Examiner, Art Unit 3714

/R. M./  
Examiner, Art Unit 3714